

Appl. No. 09/905,718
Amdt. dated April 21, 2005
Reply to Office action of December 22, 2004

Remarks/Arguments

1. Rejections under 35 USC § 132

In the Office action, it was stated that the amendments filed on January 16, 2004 and July 19, 2004 were objected to under 35 USC section 132 as allegedly introducing new matter into the disclosure.

i. *Amendment filed January 16, 2004*

More specifically, the amendment filed January 16, 2004 was objected to as allegedly introducing the following new matter into the disclosure:

- (A) In paragraph 19 and Figure 1B, a substance 22 is generically referred to, however, the original specification only defined this material as a "polymerizable composition" [hereinafter referred to as objection A];
- (B) In paragraph 19, "Preferably, substance 22 is...without requiring high pressure" [hereinafter referred to as objection B];
- (C) In paragraph 20, a curing agent 24 is generally referred to, however, the only curing agent defined in the original specification is an "activating light" [hereinafter referred to as objection C]; and
- (D) Almost entire disclosure of paragraphs 22-24 [hereinafter referred to as objection D].

Referring to MPEP, section 2163.07(b) it is stated,
"[i]nstead of repeating some information contained in

Appl. No. 09/905,718
Amdt. dated April 21, 2005
Reply to Office action of December 22, 2004

another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. Replacing the identified material incorporated by reference with the actual text is not new matter."

The present application incorporates by reference United States Patent Application No. 09/698,317 (now United States Patent 6,873,087) to Choi et al. [hereinafter referred to as Choi]. Therefore, the information contained within Choi is deemed to be repeated in the present application. To that end, the amendment filed on January 16, 2004 contained subject matter recited by Choi. Specifically, objection A is recited in column 7, line 33 of Choi; objection B is recited in column 7, lines 36-39 of Choi; objection C is recited in column 7, line 40 of Choi; and objection D is recited in column 7, line 59 - column 8, line 32 of Choi. As a result, the subject matter of the amendment filed on January 16, 2004 does not introduce new matter as it was incorporated by reference and is simply being repeated in the present application. Thus, the Applicants respectfully submit that the amendment filed on January 16, 2004 does not introduce new matter into the disclosure and the claims, as amended, satisfy the requirements of 35 USC section 112, first paragraph.

Appl. No. 09/905,718
Amdt. dated April 21, 2005
Reply to Office action of December 22, 2004

ii. *Amendment filed July 19, 2004*

To expedite prosecution of the present application and while neither confirming nor denying the veracity of the rejections, the Applicants have cancelled the material that was alleged to introduce new matter of the Amendment filed July 19, 2004. As a result, the Applicants respectfully contend that the aforementioned rejections have been traversed.

2. Claim Objections

In the Office Action, claims 88 and 104 were objected to for formalities. More specifically, claims 88 and 104 were objected to for containing the phrase "further includes." To the end, claims 88 and 104 were amended such that the same contain the phrase "further including."

3. Rejections under 35 USC 112, first paragraph

In the Office Action, claims 85, 94, and 101 were rejected under 35 USC section 112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically, claims 85, 94, and 101 were rejected as allegedly encompassing a genus invention that is broader than which the original specification conveys the Applicants possessed at the time the application was filed. To overcome this rejection, the Applicants have amended claims 85, 94, and 101. It is believed that based upon these amendments, claims 85, 94, and 101, as amended,

Appl. No. 09/905,718
Amdt. dated April 21, 2005
Reply to Office action of December 22, 2004

comport with the provisions of 35 USC section 112, first paragraph.

4. Rejections under 35 USC § 112, second paragraph

In the Office Action, claims 86 and 95 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter with the Applicants regarded as the invention. To that end, claims 86 and 95 have been amended such that the same comport with the requirements of 35 USC section 112, second paragraph.

5. Amendments to the Claims

In the Office Action, claims 85, 94, and 101 were rejected under 35 USC § 102(e) as being anticipated by United States Patent 6,391,217 to Schaffer et al. [hereinafter referred to as Schaffer]. To summarize the standard, rejections under section 102 are proper only when one prior art reference discloses every feature of the claimed invention so that there is no physical difference between the reference and the claimed invention. (See In re Marshall, 198 USPQ 344 (CCPA 1978)).

Claims 85, 94, and 101, as amended, define a method of creating a desired pattern on a body, the method including, *inter alia*, arranging a liquid to be between a template and the body; orienting the template proximate to the liquid; defining an electric field, having a magnitude associated therewith, between the substrate and the template; and increasing a distance between the substrate and the template while concurrently increasing the magnitude of the electric field to form a contiguous region of the liquid.

Appl. No. 09/905,718
Amdt. dated April 21, 2005
Reply to Office action of December 22, 2004

Applicants advocate this method in order to create a pattern in a liquid that does not come into contact with the surface of the template. Specifically, Applicants' claimed invention abrogates the need for mechanical separation of the template from the liquid, and thus, minimizing, if not preventing, a potential source of defects in the pattern. (See paragraph [0028]).

Schaffer is completely silent with respect to increasing a distance between a substrate and a template while concurrently increasing a magnitude of an electric field, defined between the substrate and the template, to form a contiguous region of the liquid. Rather, Schaffer is directed to forming an electric field between a first and a second electrode having a film disposed on the first electrode. The voltage causes surface undulations in the film until the film contacts the second electrode, producing a structure. The film is subsequently hardened or solidified to persevere the structure. (See column 5, lines 5-21). Schaffer has no mention of increasing the magnitude of the electric field, much less increasing the magnitude of the electric field while increasing the distance between the first and second electrodes to "draw out" the liquid to form a desired pattern therein, (see paragraph [0028]), as described by Applicants' claimed invention. As a result, Schaffer does not direct his invention to increasing a distance between a substrate and a template while concurrently increasing a magnitude of an electric field, defined between the substrate and the template. Moreover, Shaffer does not recognize the problem

Appl. No. 09/905,718
Amdt. dated April 21, 2005
Reply to Office action of December 22, 2004

the Applicants address of abrogating the need for mechanical separation of the template from the liquid. This precludes Schaffer from suggesting Applicants' claimed invention. See In re Nomiya, 184 USPQ 607, 612 (CCPA 1975) (finding that where prior art fails to recognize the problem at all, the claimed invention may be deemed patentable).

Based upon the forgoing, the Applicants respectfully contend that Schaffer does not anticipate the invention defined by claims 85, 94, and 101, as amended, and a *prima facie* case of obviousness is not present with respect to claims 85, 94, and 101, as amended.

6. The Non-obviousness of the Dependent Claims

Considering that the dependent claims include all of the features of the independent claims from which they depend, these claims are patentable to the extent that the independent claims are patentable. Therefore, the Applicants respectfully contend that the dependent claims define a method suitable for patent protection.

Appl. No. 09/905,718
Amdt. dated April 21, 2005
Reply to Office action of December 22, 2004

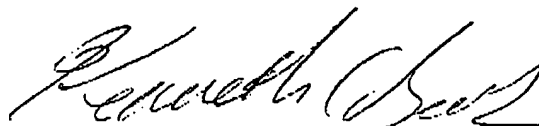
The Applicants respectfully requests examination in view of
the remarks. A notice of allowance is earnestly solicited.

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this
correspondence is being facsimile
transmitted to the USPTO or
deposited with the United States
Postal Service with sufficient
postage as first class mail, in
an envelope addressed to the
Commissioner for Patents.

Signed: Katrina Pratt
Typed Name: KATRINA PRATT
Date: 4-21-05

Respectfully Submitted,



Kenneth C. Brooks
Reg. No. 38,393

Legal Department
Molecular Imprints, Inc.
P.O. Box 81536
Austin, Texas 78708-1536
Telephone: 512-339-7760
Facsimile: 512-491-8918